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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,987	02/09/2004	Robert C. Schmidt JR.	1927D.BKB	9579

7590 05/20/2004

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/774,987	Applicant(s) SCHMIDT ET AL.	
	Examiner William K Cheung	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/9/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-13 and 24-27 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-13, 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0209</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Specification (Page 1), please include a first paragraph to state the relationship of instant application with the parent application 09/844,907.
2. In view of Preliminary Amendment filed, Claims 1-10, 14-23 have been canceled, and new claims 26-27 have been added. Claims 11-13, 24-27 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 11-12, 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroll et al. (US 6579915).

*The invention of claims 11-12, 26-27 relates to an **embossed product** comprising a **cured hot melt adhesive**.*

*The invention of claims 24-25 relates to a **casemaking machine** comprising a **curing apparatus**.*

Kroll et al. (col. 18, line 60-65 and claim 1) disclose the use of radiation curable hot melt adhesive for casemaking. Because casemaking is an art of book binding and book embossment, the examiner has a reasonable basis to believe that the claimed "embossed" feature and the claimed curing apparatus

The difference between the invention of claims 11-12, 24-27 and Kroll et al. is that Kroll et al. are silent on the claimed "embossed product" and the casemaking machine for making the same.

However, because casemaking technology is technology primarily for making embossed product for mass distribution, motivated by the expectation of success of making using the hot melt adhesive for casemaking, it would have been obvious to one

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of ordinary skill in art to recognize the value of having a machine for the mass production of embossed case products. Therefore, the claimed embossed product and the machine of making the same are considered obvious in view of Kroll et al.

5. Claims 11, 13, 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al. (US 6,479,126).

*The invention of claims 11, 13, 26-27 relates to an **embossed product** comprising a **cured hot melt adhesive**.*

*The invention of claims 24-25 relates to a **casemaking machine** comprising a **curing apparatus**.*

Yang et al. (abstract) disclose reactive hot melt polyurethane adhesives useful for bookbinding application such as casemaking. Further, Yang et al. (col. 4, line 31-37, Fig. 1 and 2) disclose that the reactive hot melt polyurethane adhesive is moisture curable. Because casemaking is an art of bookbinding and book embossment, the examiner has a reasonable basis to believe that the claimed "embossed" feature and the claimed curing apparatus

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The difference between the invention of claims 11, 13, 24-27 and Yang et al. is that Yang et al. are silent on the claimed "embossed product" and the casemaking machine for making the same.

However, because casemaking technology is technology primarily for making embossed product for mass distribution, motivated by the expectation of success of making using the hot melt adhesive for casemaking, it would have been obvious to one of ordinary skill in art to recognize the value of having a machine for the mass production of embossed case products. Therefore, the claimed embossed product and the machine for making the same are considered obvious.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'William K. Cheung', with a stylized, looping flourish extending to the right.

William K. Cheung

Primary Examiner

May 15, 2004